

II. REMARKS

Reconsideration and entry of Applicant's declaration under 37 C.F.R §1.131 is respectfully solicited. The declaration and supporting documents clearly establish that the reference Wang, U.S. Patent No. 6,175, 922, ("Wang"), first cited in the Office Action mailed December 2, 2004, is not a proper prior art reference for purposes of 35 U.S.C. §102(e). The response was timely filed and received by the USPTO. Therefore, the Office Action and rejection of December 2, 2004 is overcome.

Applicant's response to the Office action of December 2, 2004, mailed on May 19, 2005, included Applicant's §1.131 declaration and supporting evidence. The supporting evidence was in the form of an Invention Report. Proof that these documents were timely submitted include the Certificate of Mailing, certifying that the filing occurred on May 19, 2005, as well as the stamped postcard. The "Postcard" indicates receipt by the United States Patent and Trademark Office OIPE on May 23, 2005. Thus, it is submitted that the response and all of the documents referenced in the response were timely filed and received by the United States Patent and Trademark Office on May 23, 2005. A copy of the response as filed is attached hereto as Exhibit A. A copy of the stamped postcard is attached hereto as Exhibit B.

Entry of the response and declaration is mandated because the Examiner first cited Wang in the Office Action mailed December 2, 2004. In the Advisory Action, the Examiner states that the affidavit or other evidence will not be

entered because applicant "failed to provide a showing of good and sufficient reason why the affidavit or other evidence is necessary and was not earlier present". This statement is clear error. Applicant's response, in paragraph 2 of Section II "REMARKS", states that the "Examiner relies on the reference Wang as sole support for the rejection of the claims of this application. Since this reference is not an effective reference there is no support cited by the Examiner to indicate any basis for the rejection based on anticipation".

The Examiner first cited Wang in the Office Action mailed December 2, 2004. Thus, the response filed on May 19, 2005 was Applicant's first opportunity to rebut the Examiner's use of this reference. This is a *prima facie* showing why the response and declaration was not (and clearly could not have been) presented earlier. Thus, the legal requirements for entry of the declaration have been satisfied, and reconsideration and entry of the affidavit is solicited.

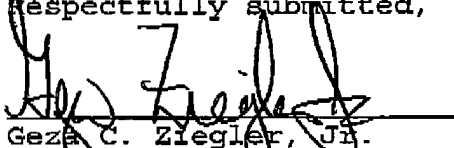
Additionally, the Examiner states the declaration does not show any reduction to practice prior to the declaration date. This is not correct.

The declaration refers to an Invention Report dated December 13, 1999. The Invention Report is referenced in the "REMARKS" section of the Response (5/19/05) as well as the 1.131 declaration. A copy of the Invention Report was submitted with the Response. Another copy is submitted herewith. Timely receipt by the USPTO of these documents is referred to above.

In conclusion, since the response filed on May 19, 2005 was Applicant's first opportunity to rebut the Examiner's use of the Wang reference, there is no legal basis for the Examiner's refusal to enter the declaration. Furthermore, the response and declaration filed on May 19, 2005 clearly establishes Applicant's reduction to practice of the invention, as evidenced by the Invention Report duly submitted. Proof that these documents were submitted and received by the USPTO is referred to above and enclosed herewith. Thus, the response and all of the documents referenced therein were timely filed and the Examiner's use of the Wang reference is clearly rebutted. Therefore, the Office Action mailed on December 2, 2004 must be withdrawn and the application either allowed or a new Office Action issued.

The Commissioner is hereby authorized to charge payment for any fees associated with this communication or credit any over payment to Deposit Account No. 16-1350.

Respectfully submitted,


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Customer No.: 2512

11 AUGUST 2005
Date

CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that this Request for Reconsideration is being transmitted by facsimile to (571) 273-8300 on the date indicated below.

Date: 11 August 2005

Signature: 
Person Making Deposit

G. ZIEGLER

EXHIBIT A

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE **RECEIVED**
CENTRAL FAX CENTER

APPLICANT(s): Matti Kantola

AUG 11 2005

SERIAL NO.: 09/848,515

ART UNIT: 2683

FILING DATE: 05/03/2001

EXAMINER: Minh D. Dao

TITLE: COMMUNICATION DEVICES AND METHOD OF
COMMUNICATION

ATTORNEY

DOCKET NO.: 617-010289-US (PAR)

Commissioner of Patents
P.O. Box 1450
Alexandria, VA 22313-1450

RESPONSE**I. INTRODUCTION**

This is in response to the Office Action mailed December 20, 2004 in regard to the above-identified patent application. Reconsideration of the rejection of the claims is respectfully solicited in light of the following remarks.

II. REMARKS

Discussion of the Cited References

The cited reference has an effective date, as a reference of March 13, 2000, namely, its U.S. filing date. The subject matter of the claims of this application have an invention date, at least as early as December 13, 1999, as shown by the attached declaration under rule 131. The declaration is based on an Invention Report signed on December 13, 1999 and attached thereto. Applicant demonstrated due diligence by filing an application on May 5, 2000, the priority date of the subject application. The cited reference Wang therefore, is not an effective reference against the subject application.

The Examiner relies on the reference Wang as sole support for the rejection of the claims of this application. Since this reference is not an effective reference, there is no support cited by the examiner to indicate any basis for the rejection based on anticipation.

Summary

For the above reason, it is respectfully submitted that all of the claims now present in the application are clearly novel and patentable over the prior art of record, and are in proper form for allowance. Accordingly, favorable reconsideration and allowance is respectfully requested. Should any unresolved issues remain, the Examiner is invited to call Applicants' attorney at the telephone number indicated below.

A check in the amount of \$1020.00 is enclosed for a three month extension of time. The Commissioner is hereby authorized to charge payment for any fees associated with this communication or credit any over payment to Deposit Account No. 16-1350.

Respectfully submitted,



Janik Marcovici
Reg. No. 42,841

5/19/05
Date

Perman & Green, LLP
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Customer No.: 2512

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service on the date indicated below as first class mail in an envelope addressed to the Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Date: 5/19/05

Signature: 
Person Making Deposit

RECEIVED
CENTRAL FAX CENTER

AUG 11 2005

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Matti Kantola

SERIAL NO.: 09/848,515

ART UNIT: 2682

FILED: May 3, 2001

EXAMINER: Minh D. Dao

TITLE: COMMUNICATION DEVICES AND METHOD OF COMMUNICATION

ATTORNEY DOCKET NO.: 617-010289-US (PAR)

Declaration Under 37 C.F.R. 1.131

I, DAVID JOHN WILLIAMS, being a representative of the assignee of this application, do hereby state that:

I am familiar with the filing of the subject application;

That said filing was initiated by the receipt of an Invention Report from the assignee of this application;

That the attached document is a true and accurate copy of said Invention Report which formed the basis of the subject application;

That the Invention report is signed December 13, 1999;

That the invention report was further read and understood by a manager of the assignee on December 14, 1999; and

that all statements made herein based on my knowledge are true and that all statements made on information and belief are believed to be true, and that I am aware that willful false statements and the like are punishable by fine or imprisonment, or both (18 U.S.C. 1001), and may jeopardize the validity of this application, document, or patent issuing therefrom.

Declarant

Dated: 13/5/05

NOKIA

23.02.00

1 (1)

Päivi Passoja

Statement of the Invention:

"Mobile equipment identification when establishing a wireless communication link"

Our ref: NC29730

Rating: 1

NMP class: M3.2

Inventors:

Name:
Matti Kantola

Address:
Yliopistokatu 44A308, 90570 Oulu

Description of the invention:

This invention solves the problem of identifying a communication device in a wireless communication environment. There may be several devices simultaneously in the range of the service access point. A connection to a specified device is needed (say, the nearest). The service access point should know the accurate distance, or the unique device address, of the device in order to establish the connection.

The problem is solved with a short range readable bar code attached on phone, containing the unique device address. The service access point is equipped with a bar code reader. The bar code could be simply a sticker attached on phone, printed on the surface of the mechanics (can be also invisible), or printed on phone display by software.

Filing schedule:

At latest 30th April 2000.

Priority filing:

UK Patent Office.

Contact information:

Our patent engineer:
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Enclosures:

Invention report.

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NOKIA**CONFIDENTIAL****INVENTION REPORT**

FAIR

Title of invention: Mobile equipment identification when establishing a wireless communication link		INVENTION REPORT RECEIVED	
		Code: 29730	Patent Committee:
THE DESCRIPTION OF THE INVENTION MUST BE ATTACHED		Place: Oulu	Date: 19.12.1999
		Signature: Pasi Permy	
Inventor's name, employee number, title and nationality: *) Matti Kantola, 10022735, Bluetooth Specialist E-Commerce, Finnish	Home Address: *) Yliopistokatu 44A308 90570 Oulu	Business Unit and cost centre: PTD Technology, 1016450	
Line Manager(s): Mikko Lukkarainen			
Project: *)		Project Manager:	
Office address: *) Elekroniikkatie 10			
Phone: *) +358405597033		Fax: *)	
The Invention becomes public on: at latest Q2/00			
I am/ We are the sole/ and original inventor(s) of this invention.			
The company may, by virtue of applicable legislation, be entitled to full or partial rights to the invention. I/ We acknowledge my/ our obligation to sign as inventor(s) all documents that may be required for protecting the invention in different countries.			
Applicable to inventions made by inventors employed in FI, DK, DE and SE only. Unless the inventor requests the Invention Report to be responded to within four (4) months from the date this Invention Report is received or such other period as the mandatory provisions of the applicable local law may otherwise require, the inventor consents to the right of the employer to use a reasonable period of time for the evaluation of the invention. A reasonable period of time may exceed four (4) months. <input checked="" type="checkbox"/> I/ We request that the Invention Report be responded to within four (4) months.			
Date: Signature(s) of Inventor(s):		13.12.1999 Matti Kantola	

*) See the instructions

I have read and understood the invention described in this Invention Report		1
Date: 14.12.1999		
Signature of Manager: [Signature]		

NOKIA**CONFIDENTIAL****DESCRIPTION OF THE INVENTION****1. Field and background of the invention**

Mobile equipment identification in wireless communication environment where distances between communicating devices are unknown or extremely difficult to identify. Communication link should be established to the specific device only (say the nearest) which cannot be known in this case.

2. A summary of the invention

Mobile equipment (A party) is attached with a bar code which contains an unique device address of the equipment. Service access point (B party) is equipped with a bar code reader capable of reading the A party's bar code containing the unique device address mentioned earlier.

When the party A is in the range of party B's bar code reader, the code is read. After that operation the party B knows the device address of the party A and a wireless communication link can be created between parties A and B using the currently know unique address for the party B. The Communication link is always established with the correct mobile equipment though there can be other mobile equipment in the wireless communication range.

3. Describe the problem which the invention overcomes

In a wireless communication environment (especially short range) the distance between the communicating devices cannot be known. There may be several devices simultaneously in the range and what is needed is a connection to a specified device only (say the nearest) willing to communicate with the service access point. It is impossible to create a connection to the correct device without knowing the accurate distance or the unique device address of the device. With a bar code which can only be read from a short range the device address can be exchanged as an basis for establishing the communication link.

4. How was the problem solved earlier?

There is no actual solving yet, but a few alternatives are listed below:

1. Distance measurement (may require complex hardware)
2. Position information (may require complex hardware)
3. Attenuating of the wireless link so that only one device fits simultaneously in the range. This is a potential solution, but there are no experiments yet how it would actually work.
4. Active authentication where user of the mobile equipment inputs a 'PIN' code which identifies the party B.

I have read and understood the invention described in this Invention Report

3

Date: 14.12.1999

Signature of Manager



NOKIA**CONFIDENTIAL****5. How does the invention improve earlier solutions? Advantages and disadvantages of the invention?**

- 100% reliability. Bar code contains the device address so the wireless communication link is always established to the correct mobile equipment.
- Proven to work. Bar code is the most common way of reading information in a short range wirelessly.
- Cost is virtually zero on mobile equipment side. Bar code can be for example a sticker or alternatively printed to the surface of the mechanics.
- Low cost on service access point side. Only a very common bar code reader is needed. No need for complex hardware for distance/position measurement or attenuator of the wireless link.

6. Brief description of the drawings (Please enclose drawings and figures of the invention on a separate document)

Appendix A shows four (4) mobile equipment (terminals) which are about to communicate with the service access point. As shown in the picture all terminals are in the range of the service access point and it cannot be known which is actually the nearest one. Service access point has a bar code reader which can read mobile equipment bar codes.

7. A more detailed description of the invention (if known at the moment)

Scenarios for the bar code usage:

General: Bluetooth is used as a wireless communication link. Later on some other wireless techniques may be feasible too.

1. Shopping / electronic transaction in general

Mobile equipment is used to make a transaction with a credit card, debit card (=pankkikortti) or electronic purse. Card information/money transfer is done using a Bluetooth communication link. Mobile equipment contains a low level unique Bluetooth address which is read by PQS and after that the communication link can be established.

2. Ticket gate

Mobile equipment contains a ticket to a movie, concert, football game, ... Ticket is used at the gate using equivalent procedure to (1).

3. Information kiosk

Mobile equipment is used to fetch information from an information kiosk.

4. ATM

Mobile equipment is used to communicate with an ATM to complete some financial operations like loading cash to an electronic purse. The secure communication link is established by exchanging the unique address of the ME stored in the bar code.

I have read and understood the invention described in this Invention Report

4

Date: 14.12.1999

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8. Explain, how the invention is/can be implemented. Which would be the best mode of implementation?

Mobile equipment: bar code in a sticker
Service access point: standard bar code reader

9. Explain how we can recognise if a competitor is using the same product/feature?

10. Is it planned to use the invention in a Nokia product? If so, when and in which product?
Is the invention standard related?

- PTD products
- electronic commerce using Bluetooth

11. Abbreviations

PTD	Personal Trusted Device
POS	Point Of Sales
PIN	Personal Identification Code

12. Any further comments

I have read and understood the invention described in this Invention Report

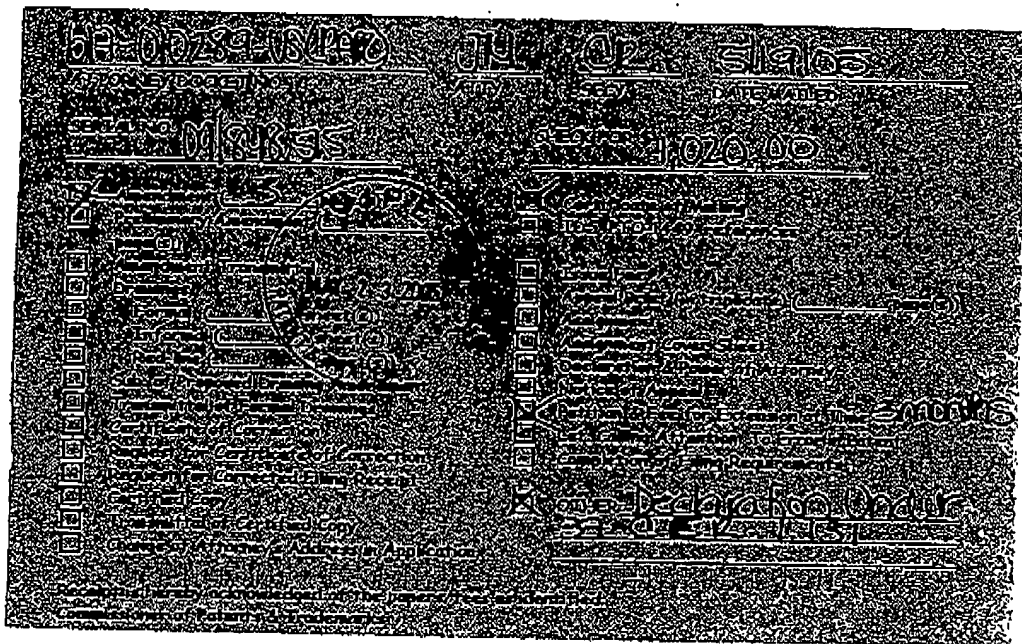
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Date: 14.12.1999

Signature of Manager



EXHIBIT B



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